

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

Claims 1-10 and 31-37 were pending in this application. In this response, claims 1 and 10 have been amended and claims 6-7 and 34-35 canceled. Thus, claims 1-5, 8-10, 31-33 and 36-37 remain pending.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims and the specification, paragraphs [0017] and [0022].

Entry of the foregoing is appropriate pursuant to 37 C.F.R. §1.116 for at least the following reasons. First, the amendments cancel claims 6-7 and 34-35, thereby reducing the number of issues present upon appeal. Second, the amendments raise no new issues that would necessitate further search and/or substantive reexamination. Third, the amendments clearly overcome the grounds of rejection.

CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-7, 9-10, 31-35 and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,829,854 to Kammerling-Essmann (hereafter "*Kammerling-Essman*") in view of U.S. Patent No. 5,537,905 to Zimmer et al. (hereafter "*Zimmer*"), the cited prior art of record on the grounds set forth on page 2 of the Office Action. Claims 8 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable

over the combination of *Kammerling-Essmann* and *Zimmer*, and further in view of U.S. Patent No. 6,464,121 to Reijnders (hereafter "*Reijnders*"), the cited prior art of record on the grounds set forth on page 3 of the Office Action. Claims 1-7, 9-10, 31-35 and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Zimmer* in view of *Kammerling-Essmann*, the cited prior art of record on the grounds set forth on page 3 of the Office Action. Claims 8 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Zimmer* and *Kammerling-Essmann*, and in further view of *Reijnders*, the cited prior art of record on the grounds set forth on page 4 of the Office Action. Each of these rejection is respectfully traversed for the following reason.

Both claims 1 and 10, the only independent claims at issue here, recite that the two cutting edge portion surfaces and the two intermediate portion surfaces are shaved. Shaved surfaces are advantageous over ground surfaces in that grinding produces scratches on the surface of the rule. When bent, the scratches are origination points for cracks in the rule which can lead to undesirable cracking when in use and reduced lifetime.

None of the cited references disclose similar shaved surfaces. *Kammerling-Essmann* discloses fine grinding in the hardened area of the bevel (col. 1, lines 29-30 and col. 2, line 6).

The reference acknowledges a shaved bevel (col. 1, line 10,) but this is not both the cutting edge and intermediate portion surfaces as claimed. Furthermore, the reference then appears to teach away from any modification that would not grind the surface of the bevel. *Kammerling-Essmann* discloses that grinding retains dimensional

accuracy of the cut bevel, implements the cutting action of the strip and increases lifetime (Col. 1, lines 38-43) all in contrast to a shaved surface. Thus one of ordinary skill in the art would not have been motivated to form shaved surfaces upon consideration of the *Kammerling-Essmann* reference because that reference so squarely teaches away from such a surface.

In view of the above, the other references have not been further discussed because the inclusion of *Kammerling-Essmann* in the combination to reject the claimed shaved surfaces is improper, as that reference teaches away from such features. Therefore, for at least this reason, a prima facie case of obviousness has not been established. Reconsideration and withdrawal of the rejection is respectfully requested.

CONCLUSION

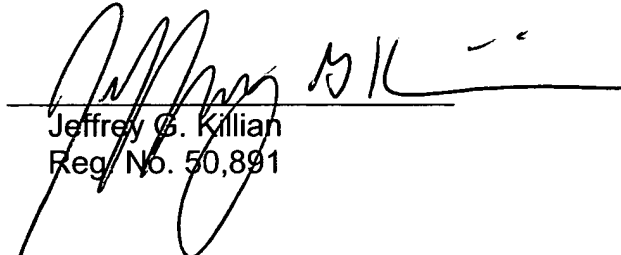
From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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